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In re Application of :
Golan, et al. :
U.S. Application No.: 09/463,726 :
PCT No.: PCT/IL98/00354 : DECISION
International Filing Date: 30 July 1998 :
Priority Date: 01 August 1997 :
Attorney's Docket No.: 00/21029 :
For: ADHESIVE COMPOSITION FOR ELECTRICAL :
PTC HEATING DEVICE :
:

On 15 March 2001, a decision was mailed herein to previous counsel. Because the 15 March 2001 decision was mailed after the 07 November 2000 submission of a Power of Attorney changing the correspondence address to the address listed above, the 15 March 2001 decision is hereby **VACATED** in lieu of the present, properly addressed decision.

In addition, a review of the application file reveals that a "Notification Of Defective Response" was mailed to previous counsel on 17 March 2003. This "Notification Of Defective Response," mailed as it was to previous counsel, is also hereby appropriately **VACATED**.

The remainder of this decision represents a restatement of the 15 March 2001 decision issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed on 04 May 2000" and the "Petition/Request For Withdrawal Of Erroneous Notification Of Missing Requirements" filed on 18 July 2000. The required petition fee has been paid.

BACKGROUND

The procedural background for this application was set forth in detail in the decision mailed by this Office on 13 June 2000. In that decision, a Notification Of Abandonment previously issued in this application was vacated based on a finding that applicants had made a timely payment of the basic national fee.

After mailing of the 13 June 2000 decision, the application was forwarded to the United States Designated/Elected Office (DO/EO/US) and, on 30 June 2000, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required.

On 18 July 2000, applicants filed the "Petition/Request For Withdrawal Of Erroneous Notification Of Missing Requirements" considered herein. This submission states that a declaration executed by one of the two inventors, accompanied by a petition under 37 CFR 1.47(a) explaining that the second inventor refused to execute the application papers, had previously been filed in this application.

A review of the application file reveals that, on 04 May 2000, applicants filed a "Petition Under 37 CFR 1.47(a)," accompanied by a declaration executed by co-inventor Gad GOLAN. The petition is considered below.

DISCUSSION

A. Withdrawal Of Notification Of Missing Requirements

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed on 30 June 2000 indicates that applicants had not filed a declaration. However, as noted above, a declaration executed by one of the two inventors, accompanied by a petition under 37 CFR 1.47(a) explaining that the second inventor refused to execute the application papers, had been filed previously (on 04 May 2000). Accordingly, the Notification Of Missing Requirements mailed on 30 June 2000, based as it was on applicants purported failure to file a declaration, is hereby appropriately vacated.

B. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(I), (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have submitted the petition fee, and the petition includes a statement of the nonsigning co-inventor's last known address. Items (1) and (2) are satisfied.

With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, the declaration submitted contains an unsigned signature block for the nonsigning co-inventor, Yuly GALPERIN, and it is executed by the other co-inventor, Gad GOLAN. Thus, item (3) is satisfied.

As for item (4), the factual proof required to demonstrate a refusal to execute the application documents is set forth in section 409.03(d) of the MPEP, which states, in part (emphasis added):

Before a refusal can be alleged, **it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.** A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Here, applicants have submitted a declaration executed by Gad GOLAN as evidence of the nonsigning inventor's refusal to execute the application documents. This declaration does not contain firsthand evidence of the prerequisite to asserting a refusal, that is, that "a copy of the application papers (specification, including claims, drawings, and oath or declaration)" was provided to the nonsigning inventor prior to the refusal. In addition, it does not provide sufficient firsthand or documentary evidence of the nonsigning inventor's refusal to execute the present application (i.e., copies of correspondence from the nonsigning inventor in which he sets forth such a refusal, or statements from persons to whom such a refusal has been made). Accordingly, applicants have failed to satisfy item (4) of the requirements for a grantable petition under 37 CFR 1.47(a).

CONCLUSION

The Notification Of Missing Requirements mailed on 30 June 2000 is **VACATED**.

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include, as discussed above: (1) firsthand evidence that a copy of the application papers (specification, including claims, drawings, and oath or declaration)" was delivered to the nonsigning inventor prior to his refusal to execute the application papers, and (2) sufficient

firsthand evidence of the acts constituting the nonsigning inventor's refusal to execute the application. **Failure to file a proper response within the time limit set forth will result in abandonment of the international application as to the national stage in the United States.**

Please address further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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